REMARKS

Claims 5-11 have been examined and have been rejected under 35 U.S.C. § 112, second paragraph, and 35 U.S.C. § 102(b).

I. Request to withdraw finality of Office Action

As noted on page 4 of the current Office Action, the Examiner contends that Applicants' claim amendments submitted in the Amendment dated February 10, 2006, necessitated the new grounds of rejection. Applicants respectfully disagree and request the Examiner to withdraw the finality of the Office Action.

Specifically, in the previous Office Action dated August 10, 2005, the Examiner rejected claims 5-10 under 35 U.S.C. § 112, first paragraph, and under the doctrine of obviousness-type double patenting. With respect to the rejection under 35 U.S.C. § 112, first paragraph, the Examiner alleged that the specification did not describe a "disc player" comprising the elements recited in the claims.

In the Amendment dated February 10, 2006, Applicants amended claim 5 to change the phrase "disc player" to "disc playing system," as shown below:

> 5. (CURRENTLY AMENDED) A disc ~~player~~ playing system connectable to a mixing apparatus which is capable of mixing two audio signals and has an operating part for adjusting a mixing level, said disc ~~player~~ playing systm comprising:
>
> an outputting part which outputs an audio signal read from a disc;
>
> a memory for storing a designated address position; and
>
> a controller which performs a control operation to start a reproduction operation when an instruction to start reproduction is received from said mixing apparatus and stop the reproduction operation and to move a pickup to an address position stored in said memory to stand by when an instruction to stop reproduction is received from said mixing apparatus.

Applicants also amended claims 6-10 in a similar manner.

In the current Office Action, the Examiner rejects claims 5-10 under 35 U.S.C. § 112, second paragraph, because the phrase "a pickup" is allegedly unclear. However, as noted above, the February 10 Amendment did not amend or otherwise change the scope or meaning of the phrase "a pickup" in claim 5 (or in claims 6-10). As such, the rejection of claims 5-10 under 35 U.S.C. § 112, second paragraph, in the current Office Action is a new ground of rejection that the amendments in the February 10 Amendment did not necessitate.

Also, the current Office Action, the Examiner rejects claims 5-10 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,257,254 to Kutaragi ("Kutaragi"). In the rejection, the Examiner contends that the reference discloses "[a] disc player or a disc player system." (Page 3 of the current Office Action). Since the amendments to claim 5 (and to claims 6-10) only changed the phrase "disc player" to "disc playing system," and since the Examiner contends that Kutaragi discloses a "disc player" and a "disc player system," the amendments to claims 5-10 did not necessitate the new ground of rejection under 35 U.S.C. § 102(b).

Thus, in the current Office Action, the Examiner issued two new grounds of rejection, and the amendments to claims 5-10 did not necessitate either ground of rejection. As such, even though Applicants added new claim 11 in the February 10 Amendment, the current Office Action should not be final. M.P.E.P. § 706.07(a). Accordingly, Applicants respectfully request the Examiner to withdraw the finality of the current Office Action.

II. Rejection under 35 U.S.C. § 112, second paragraph

Claims 5-11 have been rejected under 35 U.S.C. § 112, second paragraph, because the phrase "a pickup" is allegedly unclear. Applicants respectfully submit that one skilled in the art would know what a "pickup" is and how it functions.

For instance, U.S. Patent No. 5,373,495 to Takada ("Takada") issued on December 13, 1994, and discloses a non-limiting example of a "pickup 18." For example, column 2, line 67, to column 3, line 8, states:

> Reference numeral 18 denotes a pickup provided on the table 6. The pickup 18 is adapted to be moved from the inside to the outside of the disk CD by a later described feed motor so as to throw a laser beam from a semiconductor laser on the pits formed on the signal recording surface on the back side of the disk CD to thereby obtain, from the reflected beam, such signals as an information signal of music, a later described sub-code, and a pickup servo signal (hereinafter these signals together will be called "pickup signal").

(Emphasis added).

Clearly, as of the effective U.S. filing date of the present application, one skilled in the art would know the scope and meaning of the phrase "a pickup," as recited in claims 5-10. As such, Applicants submit that claims 5-10 are not indefinite and satisfy the requirements of 35 U.S.C. § 112, second paragraph.

III. Rejection under 35 U.S.C. § 102(b) over Kutaragi

Claims 5-11 have been rejected under 35 U.S.C. § 102(b) as being unpatentable over Kutaragi. Applicants submit that the claims are patentable over the reference.

A. Claim 5

For example, claim 5 recites a mixing apparatus which is capable of mixing two audio signals. The Examiner contends that mixer 28 shown in Fig. 8 of the reference corresponds to the claimed mixing apparatus, but Applicants respectfully disagree.

For example, as described in Kutaragi, a subcode detecting circuit 13 receives reproduced data from a descramble circuit 12, detects subcode information from the data, and supplies the subcode information to a central control apparatus 15. (Column 16, lines 41-49). Then, the central control apparatus 15 instructs an address generating circuit 26 to generate a predetermined address signal having a format that corresponds to the format of the subcode information. (Column 16, lines 53-60).

Afterwards, a subcode encoder 27 encodes the address signal and supplies the encoded address signal to the mixer 28. (column 16, lines 60-63). Then, the mixer 28 mixes the encoded address signal with digital data input from an input terminal 29 and outputs the mixed signal to the recording and reproducing apparatus 1. (Column 16, line 64, to column 17, line 4).

Since the mixer 28 only receives an encoded address signal from the encoder 27 and the input digital data from the terminal 29, it is not capable of mixing <u>two audio</u> signals. As such, the mixer 28 does not disclose or teach the claimed mixing apparatus, and claim 5 is patentable over Kutaragi.

B. Claim 6

Since claim 6 depends upon claim 5, Applicants submit that it is patentable at least by virtue of its dependency.

C. Claim 7

Since claim 7 contains features that are analogous to the features recited in claim 5, Applicants submit that it is patentable for analogous reasons.

D. Claim 8

Since claim 8 depends upon claim 7, Applicants submit that it is patentable at least by virtue of its dependency.

E. Claim 9

Since claim 9 contains features that are analogous to the features recited in claim 5, Applicants submit that it is patentable for analogous reasons.

F. Claim 10

Since claim 10 depends upon claim 9, Applicants submit that it is patentable at least by virtue of its dependency.

G. Claim 11

Since claim 11 contains features that are analogous to the features recited in claim 5, Applicants submit that it is patentable for analogous reasons.

IV. Newly added claims

Applicants have added new claims 12-15. Since such claims depend upon claim 5, 7, 9, or 11, Applicants submit that they are patentable at least by virtue of their dependency.

V. Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the

Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

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